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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,407	06/02/2005	Akihiro Miyashita	38036	6757

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PEARNE & GORDON LLP  
1801 EAST 9TH STREET  
SUITE 1200  
CLEVELAND, OH 44114-3108

EXAMINER
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HERNANDEZ, NELSON D

ART UNIT	PAPER NUMBER
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2622

NOTIFICATION DATE	DELIVERY MODE
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02/07/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patdocket@pearne.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/529,407	<b>Applicant(s)</b> MIYASHITA ET AL.	
	<b>Examiner</b> Nelson D. Hernández	<b>Art Unit</b> 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/29/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because in Fig. 5, Step S509 the word "BASK" should be corrected to read "MASK". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Objections***

3. **Claim 3** is objected to because of the following informalities: in lines 11-12, the limitations "wherein the combination image holding unit holds the plurality of combination object images which are..." should be written as "wherein the combination image holding unit holds a plurality of combination object images which are...".

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iijima et al., US Patent 6,621,524 B1 in view of Andaashu, JP 2001-285420 A.**

**Regarding claim 1**, Iijima et al. discloses an imaging device (Fig. 1) including an image pickup unit (Fig. 1: 2) and a base image record section (Fig. 1: 14) for recording a base image, and having an image processing function of combining a picked-up image picked up by the image pickup unit and the base image to generate a composite image

(this is performed by PCU 21 as discussed in col. 18, line 48 – col. 19, line 5; col. 19, lines 26-31; col. 20, lines 26-62; col. 21, lines 3-42), the mobile telephone comprising: a composite image record section (Flash memory 14 as shown in fig. 1; col. 5, lines 11-28; col. 6, lines 43-53) which records the composite image; a mask image data record section (Fig. 1: 14B; col. 5, lines 15-28) which records a plurality of types of mask image data representing mask images to specify a combining position of a combination object image (cut-out image) as a picked-up image to be combined with the base image on the base image and an image pickup area for picking up the combination object image by the image pickup unit, the mask images corresponding to the base image (Iijima et al. discloses using the mask image to create a cut-out image of a particular image that is captured and combining said cut-out image to another image that is used as a base image as taught in col. 18, line 48 - col. 21, line 21 referring to figs. 9 and 12A and illustrated in figs. 11 and 13; also in another embodiment Iijima et al. discloses combining the cut-out image data with previously recorded image data as taught in col. 23, line 60 – col. 25, line 30)); a reading unit (CPU 21) which reads the mask image data selected from among the plurality of types of mask image data from the mask image data record section (col. 18, line 56 – col. 19, line 5); a display unit (Fig. 1: 20) which displays the mask image based on the mask image data read by the reading unit on a display (Col. 19, lines 15-25); a combination object image holding unit which holds the combination object image which is picked up in accordance with the mask image displayed on the display (See col. 20, lines 25-62, where the user judges whether to confirm the composed image that is displayed); an image combining unit (CPU 21 as

shown in fig. 1) which combines the combination object image held by the combination object image holding unit with the base image at the combining position specified by the mask image data (the composed image includes the cut-out image (read as the combination object image) that is obtained by using a mask to cut a particular portion of the image, and the base image (image that is captured using the cutout image overlaying as shown in fig. 13)); and a recording unit (Fig. 1: 14) which records a composite image combined by the image combining unit in the composite image record section (Col. 5, lines 15-23; col. 6, line 43 – col. 7, line 5; col. 16, lines 47-63; col. 18, line 48 – col. 21, line 35; col. 23, line 60 – col. 25, line 30 in regards to fig. 17).

Iijima et al. discloses the invention in a camera but does not explicitly disclose the invention performing the composition apparatus in a mobile telephone.

However, the concept of having mobile telephone performing composition features is known as taught by Andaashu. Andaashu discloses a mobile telephone (See fig. 1: 6 and fig. 2) including an image pickup unit (Fig. 2: 20) and a base image record section (Fig. 2: 22) for recording a base image, and having an image processing function of combining a picked-up image picked up by the image pickup unit and the base image to generate a composite image (using image processor 21 as shown in fig. 2), the mobile telephone comprising: a composite image record section which records the composite image (composite images are recorded in image memory 22. See Machine English Translation, page 7, ¶ 0041); a mask image data record section (mask image data is recorded in memory 22 as shown in fig. 2. See Machine English Translation, page 7, ¶ 0035) which records a plurality of types of template image data

(background image) representing template images to specify a combining position (as shown in fig. 4, the template images specify the position of the object to be photographed, i.e. in the case of the background images 1-5, the object should be placed in the center and in the case of background image 6, the object should be placed to the left of the background template) of a combination object image (image already stored in memory or being captured in real time); a reading unit (image processor 21 as shown in fig. 2) which reads the mask image data selected from among the plurality of types of mask image data from the mask image data record section (See Machine English Translation, page 6, ¶ 0035 – page 7, ¶ 0039); a display unit (Fig. 2: 19) which displays the mask image based on the mask image data read by the reading unit on a display (See figs. 4a and 4b; see Machine English Translation, pages 6-7, ¶ 0035); a combination object image holding unit which holds the combination object image which is picked up in accordance with the mask image displayed on the display (See machine English Translation, page 7, ¶ 0040); an image combining unit (image processor 21 as shown in fig. 2; Machine English Translation, page 7, ¶ 0039-0041) which combines the combination object image held by the combination object image holding unit with the template image at the combining position specified by the template image data; and a recording unit (Fig. 2: 22) which records a composite image combined by the image combining unit in the composite image record section (Machine English Translation, page 7, ¶ 0039-0041) (Machine English Translation, page 4, ¶ 0018-0023; page 5, ¶ 0027-0030; page 6, ¶ 0033-0035; page 7, ¶ 0038-0042; page 8, ¶ 0045-0048).

Therefore, taking the combined teaching of Iijima et al. in view of Andaashu as a whole, it would have been obvious to one of an ordinary skill in the art at the time the invention was made to modify Iijima et al. by having the camera functions incorporated in a mobile telephone. The motivation to do so would have been to improve the capabilities of the camera by having the ability to transmit the captured images to other devices allowing the user to share the images with friend or to store the images in a remote location.

**Regarding claim 2**, the combined teaching of Iijima et al. in view of Andaashu teaches that the display unit displays a preview image generated by combining the mask image and the base image on the display when the display unit displays the mask image on the display (See Iijima et al., col. 19, lines 15-25, see also Andaashu, Machine English Translation, pages 6-7, ¶ 0035).

**Regarding claim 3**, the combined teaching of Iijima et al. in view of Andaashu teaches that the plurality of types of mask image data recorded in the mask image data record section include the mask image data representing a plurality of types of mask images corresponding to the base image (See Iijima et al., col. 16, lines 47-63; col. 18, line 48 – col. 21, line 35); wherein the display unit displays the plurality of types of mask images based on the mask image data one at a time on the display until the combination object image which is picked up in accordance with the mask image is held by the combination object image holding unit (See Iijima et al., col. 16, lines 47-63; col. 18, line 48 – col. 21, line 35; col. 23, line 60 – col. 25, line 30); wherein the combination object image holding unit holds a plurality of combination object images which are



picked up in accordance with the plurality of types of mask images displayed on the display (See Iijima et al., col. 20, lines 25-62, where the user judges whether to confirm the composed image that is displayed; Iijima et al also discloses storing a plurality of cut-out images to be used in the image composition function (col. 8, lines 59-67; col. 9, lines 47-62; col. 13, lines 7-15)); and wherein the image combining unit combines each of the plurality of combination object images, held by the combination object image holding unit, with the base image at the combining position based on the mask image to specify the image pickup area of the combination object image (Iijima et al discloses that the image combination can be performed to images previously stored in the flash memory with the cut-out images (read as combination object images), this teaches that when the user selects an image that was previously synthesized as a base image to be combined with a different cut-out image, the combining unit is combining each of the plurality of combination object images, held by the combination object image holding unit, with the base image at the combining position based on the mask image to specify the image pickup area of the combination object image; see col. 25, line 36 – col. 26, line 64 in regards to ; see also col. 16, lines 47-63; col. 18, line 48 – col. 21, line 35; col. 23, line 60 – col. 25, line 30).

**Regarding claim 4**, limitations can be found in claim 2.

**Regarding claim 5**, the combined teaching of Iijima et al. in view of Andaashu teaches that when the combination object image which is picked up based on each of a plurality of types of image pickup areas specified by the mask image data is already held in the combination object image holding unit, the display unit combines the held

combination object image with the base image at the combining position based on the mask image to specify the image pickup area for picking up the held combination object image and displays the composition image on the display (See Iijima et al., col. 20, lines 25-62, where the user judges whether to confirm the composed image that is displayed; Iijima et al. also teaches using masks having a plurality of image pick up areas to cut-out a plurality of portions of the image; see col. 11, lines 41-55, also col. 29, lines 47-60).

**Regarding claim 6**, the combined teaching of Iijima et al. in view of Andaashu teaches that whenever the image pickup unit picks up an image based on the mask image displayed on the display and the picked-up combination object image is held by the combination object image holding unit, the image combining unit combines the held combination object image with the base image in order (See Iijima et al., col. 20, lines 25-62; col. 18, line 48 - col. 21, line 21); and wherein after the image combining unit combines all the combination object images with the base image, the recording unit records a composite image provided by the image combining unit in the composite image record section (See Iijima et al., col. 5, lines 15-23; col. 6, line 43 – col. 7, line 5; col. 16, lines 47-63; col. 20, lines 25-62; col. 18, line 48 - col. 21, line 21).

**Regarding claim 7**, the combined teaching of Iijima et al. in view of Andaashu teaches that when a picking up of the combination object image to be combined with the base image is canceled on the way, the image combining unit combines the combination object image, which is picked up by the image pickup unit and which is held by the combination object image holding unit before the picking up of the image is

canceled, with the base image (Iijima et al discloses that the cut-out image that is used to create the combined image with the base image can be selected from the memory (14a) where previously stored cut-out images are stored, thus if an image being picked up of the combination object image to be combined with the base image is canceled on the way, the user can select a previously recorded cut-out image to be combined with a base image to create a new synthesized image; col. 16, lines 47-63; col. 18, line 48 – col. 21, line 35; col. 23, line 60 – col. 25, line 30).

### ***Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson D. Hernández whose telephone number is (571) 272-7311. The examiner can normally be reached on 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye can be reached on (571) 272-7372. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Nelson D. Hernández  
Examiner  
Art Unit 2622

NDHH  
January 29, 2008

A handwritten signature in black ink, appearing to read 'Lin Ye', with a stylized flourish at the end.

LIN YE  
SUPERVISORY PATENT EXAMINER